

REMARKS

By this Amendment, Applicants have amended the specification and Figures to address the Examiner's objection to the drawings set forth in the final Office Action. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended specification and drawings. No new matter is introduced.

In regard to the Examiner's requirement of drawings for the features of claims 34-37, 39, and 40, Applicants submit that such features are adequately described in the description and claims and that detailed illustration is not required for a proper understanding of the invention. Nonetheless, with respect to claims 37, 39, and 40, Applicants comply with the Examiner's request by adding Figs. 3-4. Exemplary support for new Fig. 3, showing a cross-wound multifilar coil, is provided on page 7, lines 3-11, of the specification and through Fig. 5 of U.S. Patent No. 4,932,419 to de Toledo, which is incorporated by reference. Exemplary support for the rectangular cross-section of Fig. 4 is provided at least in the length and width descriptions on page 6, lines 15-18, of the specification. Applicants submit that the claimed embodiments are adequately described in the current drawing Figures, and that a drawing showing a lubricious and/or colored coating is not required to understand the invention. If the Examiner disagrees with Applicants' response to the drawing objection, he is invited to contact the undersigned at 202-408-4140.

Claims 22, 25, 26, 28-30, and 32-40 are pending in this application. In the Office Action dated December 30, 2003, the Examiner rejected each claim under 35 U.S.C. § 102(b) and/or § 103(a) in view of one or more of U.S. Patent No. 5,067,489 to Lind, U.S. Patent No. 6,139,640 to Rost et al., U.S. Patent No. 6,245,030 to DuBois et al., U.S.

Patent No. 6,106,485 to McMahon, U.S. Patent No. 5,947,940 to Beisel, U.S. Patent No. 5,885,227 to Finlayson, and U.S. Patent No. 5,997,517 to Whitbourne.

With this amendment, Applicants have amended claim 22 in order to more clearly define the claimed invention. Support for amendment is provided in drawing Fig. 2 and page 10, lines 5-15 of the specification. In so far as the Examiner's rejections apply to the amended claims, those rejections are respectfully traversed for the reasons set forth below. Applicants respectfully request reconsideration and allowance of the pending claims in view of the following remarks.

Claim Rejections - 35 U.S.C. § 102(b)

In the final Office Action, the Examiner rejected claims 24-26, 28, 34, 35, 37, and 38 under 35 U.S.C. § 102(b) as being anticipated by Lind. As a preliminary matter, it is noted that claim 24 was canceled in the Amendment Filed October 2, 2003. For the purposes of this response, Applicants assume that the Examiner intended to reject claims 22, 25-26, 28, 34, 35, 37, and 38. If this understanding is incorrect, Applicants respectfully request clarification in reply to this communication.

Independent claim 22, as amended recites, *inter alia*, a guide wire comprising an elongate core having proximal and distal portions. The guide wire further includes a continuous, unitary coil that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core. A polymeric tip extends from a distal portion of the coil. The tip connects to the core by a polymeric material. None of the cited references disclose or suggest at least these aspects of the claimed invention either alone or in combination with the other aspects of the claimed invention.

Lind does not disclose or suggest, in any of its embodiments, at least the combined features of a coil that extends distal of the distal portion of the core, and a polymeric tip extending from a distal portion of the coil and connecting to the core by a polymeric material, as recited in claim 22.

Figs. 1, 3, and 4 of Lind disclose three embodiments of a guide wire. In the embodiment of Fig. 1, guide wire 10 includes a core 12, having a plug 14. Wire 10 further includes a tip 28 composed of a polymeric bonding agent material 22. In the embodiment of Fig. 1, core 12 and its integral plug 14 extend distal of the coil 20. This embodiment therefore fails to disclose the feature of a coil which “extends distal of the distal portion of the core”. In the embodiment of guide wire 10” of Fig. 4, core 12” and its plug 40 similarly extend distal of coil 20”. Therefore, that embodiment also fails to disclose that claimed feature.

In paragraph 4 of the Office Action, the Examiner relies on the guidewire of Fig. 3 of Lind as corresponding to the claim elements. In that embodiment, coil 20’ extends distally of nitinol core 12’. A safety wire 32 extends to a plug 14’. A polymer bonding agent 22’ is provided between coil 20’ and the shoulder of plug 14’. The embodiment of Fig. 3 relied upon by the Examiner however, fails to disclose any connection between the tip and the core. Accordingly, the embodiment of Fig. 3 fails to disclose a “a polymeric tip extending from a distal portion of the coil, wherein the tip connects to the core by a polymeric material.”

As no single embodiment in Lind teaches the elements of a coil extending distal of the core and a connection between the tip and the core, Lind does not anticipate claim 22. Furthermore, Lind fails to provide any motivation or suggestion for modifying

any of the embodiments to provide such a teaching. Any proposed modification would be based purely on hindsight, and based on the Applicants' own disclosure. For at least these reasons, Applicants respectfully request that the rejection of claims 22, 25-26, 28, 34, 35, 37, and 38 as being anticipated by Lind be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

In the final Office Action, the Examiner rejected claims 22, 25, 26, 28, 30, 33-35, and 38-40 under 35 U.S.C. § 103(a) as unpatentable over Rost et al. in view of Lind. Claim 22, as amended, is directed to a guide wire that includes a polymeric tip which extends from a distal portion of the coil and connects to the core by a polymeric material. Neither Rost et al. nor Lind, alone or in combination, teach or suggest such a guide wire.

Rost et al. discloses a guide wire, as illustrated in FIG. 4, including a core wire 60 and a wire coil 62 extending to a tip comprised of a distal weld 40. There is no connection between weld 40 and core 60. For the reasons discussed in greater detail above, Lind does not compensate for the deficiencies of Rost et al. Accordingly, Applicants respectfully request that the rejection of claims 22, 25, 26, 28, 30, 33-35, and 38-40 as being unpatentable over Rost et al. in view of Lind be withdrawn.

In the final office action, the Examiner rejected claims 22, 25, 26, 28, 30, 34, 35, 37, and 38 under 35 U.S.C. § 103(a) as unpatentable over DuBois et al. in view of McMahon. As noted above, claim 22 is directed to a guide wire that includes a polymeric tip which extends from a distal portion of the coil and connects to the core by

a polymeric material. Neither DuBois et al. nor McMahon, alone or in combination, teach or suggest such a guide wire.

DuBois et al. discloses a guide wire, as illustrated in FIG. 1, including a core wire 12 and a wire coil 14 extending to a distal tip 18. A safety wire 24 is connected to the guide wire distal tip 18. There is no connection between tip 18 and core 12. McMahon does not compensate for the deficiencies of DuBois et al. Accordingly, Applicants respectfully request that the rejection of claims 22, 25, 26, 28, 30, 34, 35, 37, and 38 as being unpatentable over DuBois et al. in view of McMahon be withdrawn.

The Examiner rejected the remaining claims 29, 32, and 36 under 35 U.S.C. § 103(a) as unpatentable over Lind in view of Beisel, Lind in view of Finlayson, and Lind in view of Whitbourn respectively. The secondary references do not compensate for the deficiencies in the teachings of Lind discussed above. Accordingly, Applicants respectfully request that the rejection of claims 29, 32, and 36 be withdrawn.

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 22, 25, 26, 28-30, and 32-40 in condition for allowance. Furthermore, the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. Entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance. Finally, entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

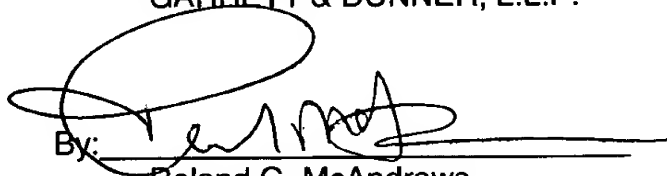
The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action. In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 26, 2004

By: 
Roland G. McAndrews
Reg. No. 41,450